

**REMARKS**

**I. Status of the Claims and Amendments**

Claims 1-8 were rejected by the Examiner. Claim 9-12 were objected to by the Examiner as being in improper form, and not further treated on the merits. Claims 1-12 remain pending. Claims 9-12 have been amended to depend from claim 1, thereby removing the multiple dependency recited in each of claims 9-12. Claim 10 has been amended to insert a period at the end of the claim. Claims 10-12 have also been amended to remove language rendered redundant by limiting the dependency of each of claims 9-12 to claim 1. Claims 1-12 have been amended so that each claim begins with an article. Because all amendments to claims 1-12 are fully supported by the original claims, these amendments do not introduce any new matter.

Page 18 of the specification has also been canceled and the description of the figures originally presented on page 18 incorporated into the brief description of the figures on page 7 of the specification. The amendments to page 7 for Figures 1, 2, and 3 are therefore fully supported in the description of the figures originally provided on pages 7 and 18 of the specification, and so also do not introduce any new matter.

**II. Information Disclosure Statement**

Applicants thank the Examiner for providing an initialed copy of the PTO Form 1449 for an Information Disclosure Statement (IDS) filed August 4, 2003. An IDS was, however, also filed on March 21, 2002, as part of the original application papers.

Applicants request the Examiner also consider the March 21, 2002, IDS and return the initialed PTO Form 1449.

### **III. Arrangement of the Specification**

The Examiner has suggested Applicants adhere to the guidelines outlining the preferred layout for the specification. (Office Action page 2.) The instant application is a National Stage filing of International Application No. PCT/EP00/08815, originally structured for filing in the European Patent Office. Because the application was not originally structured to accommodate these preferred headings, their inclusion could create inaccurate subdivisions within the instant specification. Applicants note the suggested specification layout, although preferred by the Office, is not required. Therefore, to avoid possible error and confusion, Applicants have not added section headings not present in the original application and respectfully request the withdrawal of this objection.

The Examiner also objects to the disclosure because she considers page 18 to be out of place. (Office Action page 3.) Because a brief description of the figures is provided both on page 18 and on page 7 of the specification, Applicants have deleted page 18 of the specification and incorporated the description of the figures provided on page 18 into the brief description of the figures found on page 7. Applicants therefore respectfully request withdrawal of this objection.

### **IV. Objection to the Claims**

The Examiner objects to claims 9-12 as being in improper form because the claims are multiple dependent claims that depend from another multiple dependent

claim. (Office Action page 3.) The Examiner states that the claims have not been examined on the merits. *Id.*

Applicants have amended claims 9-12 to remove the multiple dependency that occurred in each of original claims 9-12. The Examiner is therefore requested to withdraw the objection and examine claims 9-12 on the merits.

**V. Rejection of Claims 1-8 under 35 U.S.C. § 103(a)**

The Examiner rejects claims 1-8 as unpatentable over the teachings of the Kunz *et al.* patent ("*Kunz*") in combination with the Willibald-Ettle *et al.* patent ("*Willibald-Ettle*"). (Office Action page 3.) The claims of *Kunz* relied upon by the Examiner recite a sweetener (e.g., claim 5) or candy (e.g., claim 21) comprising 45% to 60% by weight of 1,1-GPM. Claim 8 of *Kunz* further indicates that the sweetener contains small amounts of sorbitol. The Examiner notes that *Willibald-Ettle* teaches hard caramels comprising 1,1-GPM and sorbitol. The Examiner states that although "the claims differ [from the teachings of the combination of the references] as to the specific amounts employed," the amounts employed are "deemed optimization" so that it would have been obvious "to use the claimed percentages in either Kunz *et al.* or Willibald-Ettle *et al.* because the use and manipulation of both 1,1-GPM and sorbitol are conventional in the production of hard candies such as caramels." (Office Action pages 3 to 4.)

The claimed invention, however, is for a hard caramel containing not only a specific range of 1,1-GPM, but also 0.5% to 3.5% sorbitol by weight. Both *Willibald-Ettle* and *Kunz* mention that sorbitol can be present in sweeteners used to make candy. *Willibald-Ettle* does not teach, however, any particular weight percentage of either 1,1-GPM or sorbitol. In addition, while claims 6 and 8 of *Kunz* recite that small amounts of sorbitol can be present in the sweetener, *Kunz* also teaches that *it is desirable to remove the sorbitol*. (Column 3 at line 62 to column 4 at line 3.)

In order to properly reject a claim as obvious in view of a combination of prior art references, the Office has the burden of establishing a *prima facie* case that:

(1) . . . the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) . . . the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure.

*In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (citations omitted). Here, the Office has failed to satisfy its burden of establishing that claims 1-8 are *prima facie* obvious over the prior art.

The Office has not satisfied its burden because it has not made a clear and particular showing that the references provide the motivation needed to make a hard caramel having the properties claimed. *Kunz* not only teaches that it is desirable to remove the sorbitol, but the Examples of *Kunz* also teach the ordinary artisan how to accomplish removing the sorbitol from sweeteners by using chromatography (e.g., Example 3 at columns 6 to 7, and Example 7 at columns 8 to 9). In addition, *Kunz*

notes that the sweetener of Example 3, which lacks sorbitol, is an "excellent sweetener" (column 7 at lines 20-22), and it is this sweetener lacking sorbitol that is used in Examples 9 and 10 to sweeten food. Further, *Kunz* teaches at column 1, lines 49-52, that mixtures of 1,6-GPS or 1,6-GPM with other sugar alcohols or sugars in the presence of sorbitol yields unsatisfactory products that are sticky. *Kunz*, when taken for all that it teaches, would not have motivated the ordinary artisan to select the particular claimed range of sorbitol for inclusion in a candy. Instead, *Kunz* motivates the ordinary artisan *to remove as much sorbitol as possible*, and *Kunz* provides chromatographic approaches for eliminating all sorbitol from a sweetener.

*Kunz* does not teach hard caramels and *Willibald-Ettle* does not teach specific ranges of 1,1-GPM and sorbitol. The Examiner's rejection therefore is evidently based on the premise that it would have been obvious to substitute a sweetener as taught by *Kunz* for the sweetener taught by *Willibald-Ettle* in its process of making hard caramels. But because *Kunz* teaches that it is desirable to eliminate sorbitol from the sweetener, the ordinary artisan would not have been motivated to substitute a sweetener that contains sorbitol in the method of making hard caramels taught by *Willibald-Ettle*. Neither does *Willibald-Ettle* provide any motivation to specifically select the recited ranges of 1,1-GPM and sorbitol based on its disclosure of a process for making hard caramels. There is no motivation for the ordinary artisan to make Applicants' invention based upon the teachings of the references. The Examiner has, therefore, failed to establish a *prima facie* case for rejecting the claims as unpatentable, and Applicants respectfully request withdrawal of this rejection.

**VI. Conclusion**

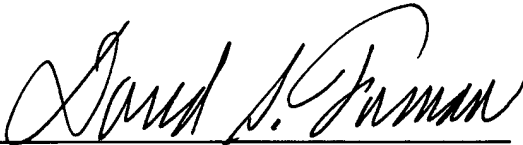
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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